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EXAMINER

HERNANDEZ, NELSON D

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NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/529,407	Applicant(s) MIYASHITA ET AL.	
	Examiner Nelson D. Hernández Hernández	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 3-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 29, 2009 has been entered.

Response to Amendment

2. The Examiner acknowledges the amended claims filed on April 29, 2009. **Claims 1, 3 and 4** have been amended. **Claim 2** has been cancelled. **Claim 8** has been newly added.

Response to Arguments

3. Applicant's arguments filed April 29, 2009 have been fully considered but they are not persuasive. The Applicant argues the following:

- a. "The Office action cites Iijima at Fig. 20C for teaching a preview image. The image of a person in Fig. 20A is cited for a base image, and a mask pattern is shown in Fig. 20B. In Fig. 20C, the star-shaped mask is superposed on the base image. The base image appears through the mask.

Assume, arguendo that the dotted portion around the mask in Fig. 20C corresponds to "the image pickup area on the base image," as recited in claim 1. The base image (i.e., image of a person) appears through the star-shaped mask in Fig. 20C, and does not surround the dotted image pickup area. A requirement of the claimed preview image is that the base image surrounds the displayed image pickup area. This feature is not shown in Fig. 20C."

➤ The Examiner acknowledges that Fig. 20C-20E in Iijima et al. does not show that the base image surrounds the displayed image area. However, in a further embodiment, Iijima et al. teaches that the user can draw any shape and use said shape as a mask (*See col. 29, line 65 – col. 30, line 60*) and taking in consideration a further teaching of the Andaashu reference, wherein the mask image data record section (*mask image data is recorded in memory 22 as shown in fig. 2. See Machine English Translation, page 7, ¶ 0035*) records a plurality of types of template image data (*background image*) representing template images to specify a combining position as shown in fig. 4, wherein the displayed template images specify the position of the object to be photographed (combination object image). In the case of the background images 1-5, the object should be placed in the center since the template surrounds the center of the displayed image area, where the image being captured is to be recorded. This teaches the concept of having the displayed preview image showing the image pickup area on the base image such that the base image surrounds the displayed image pickup area (*See templates 1-5 as shown in fig. 4*), and wherein subsequent to

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displaying the preview image, the display unit displays the composite image showing the combination object image as a through image on the base image and located within the image pickup area (*as shown in fig. 5, Andaashu teaches displaying the preview image, which includes the template and the image to be captured as a through image on the template (base image) and located within the image pickup area. Although the 6th template is shown in combination with the image to be captured it is noted that the same would occur if selecting any of the 1-5 templates*). Therefore, the Examiner understands that the combined teaching of Iijima et al. in view of Andaashu teaches the new limitations as presented as will be discussed in the Office Action below.

b. "Claim 1 further requires that a composite image be displayed. The composite image shows the combination object image as a through image on the base image. In addition, Claim 1 recites, "the combination object image to be combined with the base image on the base image" (emphasis added). Fig. 20E of Iijima is cited for a composite image, with the image of the car being cited for a combination object image. The caption in Fig. 20E clearly states that the cut-out image (i.e., the image of the person cited for a base image) is positioned on another image (i.e., the image of the car) and can be moved to a desired position on the image of the car. Unquestionably, in Fig. 20E, the "base image" of the person is shown on the "combination object image" of the car. This is contrary to

claim 1, which requires that the combination object image be shown as a through image on the base image.

To summarize, the claimed display displays a preview image showing an image pickup area surrounded by a base image, and subsequently a combination object image within the image pickup area on the base image. This can allow a user to view the preview image and approve the placement of the image pickup area on a base image before the combination object image is picked up and displayed on the base image within said image pickup area.

Further, the combination object image is displayed through the base image. This system is opposite to the teaching in Iijima Fig. 20A-20E, in which a portion of a "base image" is cut out and placed atop a "combination object image."

The deficiencies of Iijima, discussed above, are not corrected by Andaashu. In view of the differences between the cited combination of references and claim 1, applicants respectfully submit that claim 1 is allowable over said combination. Claims 3-7 depend from claim 1."

➤ The Examiner would like to point out as discussed above that although Iijima et al. does not go into specific details of having the base image surrounding the combination object image. However, Iijima does teaches that the base image can be generated as desired by the user, which can draw a particular mask to be applied to the base image (*See col. 29, line 65 – col. 30, line 60*). Also, it seem that the Applicant is arguing that the combination object image is displayed on the base image taking in consideration that the base image surrounds the

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combination object image as opposed to the teaching of Iijima, where the combination object image in Fig. 20E surrounds the base image (as interpreted by the Examiner) since the base image can be displaced from a particular position to another on an already picked up image. However, as discussed in the previous Office Action, Iijima further teaches combining a image being picked up with the image pickup unit (*image with the car 21 as shown in figs. 13A-13D*) with a previous image generated by combining a base image (*image of a person previously captured and combined with a mask pattern (See figs. 10A-10D)*) to form a composite image (*See col. 19, line 58 – col. 21, line 42*). This suggests also displaying the base image in combination with an image to be captured. Furthermore, the fact that the user is moving the base image on top of the image to be captured, does not preclude the user to also move the camera to have the image being picked up at a particular placement as desired. And, after considering the teaching of Andaashu, where the combination object image is displayed on the base image so that the combination object image is displayed as a through image, the Examiner understands that the combined teaching of Iijima et al. in view of Andaashu as a whole teaches the limitations of claim 1 as presented, as will be discussed in this Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima et al., US Patent 6,621,524 B1 in view of Andaashu, JP 2001-285420 A.**

6. **Regarding claim 1, Iijima et al.** discloses an imaging device (*Fig. 1*) including an image pickup unit (*Fig. 1: 2*) and a base image record section (*Fig. 1: 14*) for recording a base image (*In an embodiment of Iijima et al. as shown in fig. 20A (Col. 25, line 50 – col. 26, line 4), Iijima et al. teaches a recorded image (image of the person) that the Examiner is interpreting as the base image that would be combined with the mask image*), and having an image processing function of combining a combination object image (*image of the car as shown in fig. 20E*) and the base image to generate a composite image (*this is performed by PCU 21 as discussed in col. 18, line 48 – col. 19, line 5; col. 19, lines 26-31; col. 20, lines 26-62; col. 21, lines 3-42; col. 25, line 62 – col. 26, line 55*), the imaging device comprising:

a composite image record section (*Flash memory 14 as shown in fig. 1; col. 5, lines 11-28; col. 6, lines 43-53*) which records the composite image;

a mask image data record section (*Fig. 1: 14B; col. 5, lines 15-28*) which records a plurality of types of mask image data representing mask images to specify a combining position of the combination object image (*as shown in fig. 20B, a plurality of*

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mask image data can be selected to combine with the base image. Note that the Examiner is reading the image displayed in fig. 20C as the combination of the base image and the mask image data, wherein the area marked with dots is being interpreted as the area that indicated the position of a combination object image (see fig. 20E); col. 25, line 62 – col. 26, line 55) to be combined with the base image on the base image (Note as shown in figs. 20C and 20D, that the mask image is combined on the base image) and an image area for positioning the combination object image (As shown in fig. 20E, the image of the car (which the Examiner is interpreting as the combination object image) is being positioned in an area surrounding the area of the base image. Note that the area of the person in fig. 20E is being interpreted as the base image. It is noted that the shape of the mask can be change to any other shape as discussed in Iijima et al. with regards to the mask pattern construction (Col. 28, lines 30-44). Therefore, although the shape in the base image appear to be a round star, that particular shape would not preclude one of an ordinary skill in the art to have different shapes and sizes for the mask image data), the mask image data corresponding to the base image (person face as shown in fig. 20E);

a reading unit (CPU 21) which reads the mask image data selected from among the plurality of types of mask image data from the mask image data record section (Col. 18, line 56 – col. 19, line 5; col. 25, line 62 – col. 26, line 55);

a display unit (Fig. 1: 20) which displays a preview image generated by combining the base image and the mask image based on the mask image data read by the reading unit on a display (See col. 19, lines 15-25; col. 26, lines 11-17. As shown in

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fig. 19: S25 and fig. 20C, a preview image generated by combining the base image and the mask image is displayed on a display);

a combination object image holding unit which holds the combination object image in accordance with the mask image of the preview image displayed on the display (*As shown in fig. 20E, CPU 21 would have the combination object image being held in accordance with the mask image of the preview image (20C); col. 25, line 62 – col. 26, line 55);*

an image combining unit (*CPU 21 as shown in fig. 1*) which combines the combination object image held by the combination object image holding unit with the base image at the combining position specified by the mask image data (*Iijima et al. teaches combining the base image (Fig. 20A) (as modified with the mask image pattern (Fig. 20B) (modified image as shown in fig. 20C)) and the combination object image (image with the car as shown in fig. 20E) which is being held in the combination object image holding unit at the combining position specified by the mask image data (the combination object image is held at a position surrounding the base image as indicated by the mask pattern). See col. 25, line 62 – col. 26, line 55); and*

a recording unit (*Fig. 1: 14*) which records a composite image combined by the image combining unit in the composite image record section (*Col. 5, lines 15-23; col. 6, line 43 – col. 7, line 5; col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30; col. 25, line 62 – col. 26, line 55).*

Although in this embodiment of Iijima et al., the combination object image is an image reproduced from the memory of the camera and does not explicitly indicates that

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the combination object image is an image being picked up by the image pickup unit, Iijima et al. teaches in a different embodiment (*Embodiment 3*) combining a image being picked up with the image pickup unit (*image with the car 21 as shown in figs. 13A-13D*) with a preview image generated by combining a base image (*image of a person previously captured and combined with a mask pattern (See figs. 10A-10D)*) to form a composite image (*See col. 19, line 58 – col. 21, line 42*). After acknowledging the concept of combining a through image with a base image modified with a mask pattern as taught in the 3rd embodiment of Iijima et al., one of an ordinary skill in the art would have found obvious at the time the invention was made to modify the teaching in the 6th embodiment of Iijima et al. to use an image that is being picked up as the combination object image. The motivation to do so would have been to improve the imaging device by allowing the user to not only combine pre-recorded image data but to capture and combine image data on the fly thus adding further functionality to the imaging device.

Iijima et al. discloses the invention in a camera but does not explicitly disclose the invention performing the composition apparatus in a mobile telephone, that the displayed preview image shows the image pickup area on the base image such that the base image surrounds the displayed image pickup area, and wherein subsequent to displaying the preview image, the display unit displays the composite image showing the combination object image as a through image on the base image and located within the image pickup area.

However, the concept of having mobile telephone performing composition features is known as taught by **Andaashu**. Andaashu discloses a mobile telephone

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(See fig. 1: 6 and fig. 2) including an image pickup unit (Fig. 2: 20) and a base image record section (Fig. 2: 22) for recording a base image, and having an image processing function of combining a picked-up image picked up by the image pickup unit and the base image to generate a composite image (*using image processor 21 as shown in fig. 2*), the mobile telephone comprising:

a composite image record section which records the composite image (*composite images are recorded in image memory 22. See Machine English Translation, page 7, ¶ 0041*);

a template image data record section (*mask image data is recorded in memory 22 as shown in fig. 2. See Machine English Translation, page 7, ¶ 0035*) which records a plurality of types of template image data (*background image*) representing template images to specify a combining position (*as shown in fig. 4, the template images specify the position of the object to be photographed, i.e. in the case of the background images 1-5, the object should be placed in the center since the template surrounds the center of the displayed image area, where the image being captured is to be recorded and in the case of background image 6, the object should be placed to the left of the background template. This teaches the concept of having a template image (base image) for displaying as a preview image showing the image pickup area on the base image such that the base image surrounds the displayed image pickup area (See templates 1-5 as shown in fig. 4)) of a combination object image (image already stored in memory or being captured in real time)*);

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a reading unit (*image processor 21 as shown in fig. 2*) which reads the template image data selected from among the plurality of types of template image data from the template image data record section (*See Machine English Translation, page 6, ¶ 0035 – page 7, ¶ 0039*);

a display unit (*Fig. 2: 19*) which displays a preview image generated by combining the template image and the image to be captured (combination object image) (*See Fig. 5*) based on the template image data read by the reading unit on a display (*See figs. 4a and 4b; see Machine English Translation, pages 6-7, ¶ 0035*), wherein the displayed preview image shows the image pickup area on the base image such that the base image surrounds the displayed image pickup area (*As shown in fig. 4 (items 1-5), the preview image shows the image pickup area on the base image such that the base image surrounds the displayed image pickup area*), and wherein subsequent to displaying the preview image (*when the user select one of the templates*), the display unit displays the composite image showing the combination object image as a through image on the base image and located within the image pickup area (*as shown in fig. 5, Andaashu teaches displaying the preview image, which includes the template and the image to be captured as a through image on the template (base image) and located within the image pickup area. Although the 6th template is shown in combination with the image to be captured it is noted that the same would occur if selecting any of the 1-5 templates*);

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a combination object image holding unit which holds the combination object image which is picked up in accordance with the template image displayed on the display (*See machine English Translation, page 7, ¶ 0040*);

an image combining unit (*image processor 21 as shown in fig. 2; Machine English Translation, page 7, ¶ 0039-0041*) which combines the combination object image held by the combination object image holding unit with the template image at the combining position specified by the template image data; and

a recording unit (*Fig. 2: 22*) which records a composite image combined by the image combining unit in the composite image record section (*Machine English Translation, page 7, ¶ 0039-0041*) (*Machine English Translation, page 4, ¶ 0018-0023; page 5, ¶ 0027-0030; page 6, ¶ 0033-0035; page 7, ¶ 0038-0042; page 8, ¶ 0045-0048*).

Therefore, taking the combined teaching of Iijima et al. in view of Andaashu as a whole, it would have been obvious to one of an ordinary skill in the art at the time the invention was made to apply the teaching of having a mobile telephone performing an image composition process wherein the telephone displays a plurality of templates, having an image pickup area on the template in a way that the template surrounds the image pickup area, and upon selection of the template by the user, displaying the composite image of including the template and the image to be captured as a through image on the template and within the image pickup area as taught in Andaashu to modify the teaching of Iijima et al. have the camera functions incorporated in a mobile telephone, to display the preview image showing the image pickup area on the base

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image such that the base image surrounds the displayed image pickup area, and wherein subsequent to displaying the preview image, the display unit displays the composite image showing the combination object image as a through image on the base image and located within the image pickup area, considering that Iijima et al teaches that the user can create the base images with any shape as desired. The motivation to do so would have been to improve the capabilities of the camera by having the ability to transmit the captured images to other devices allowing the user to share the images with friend or to store the images in a remote location and to further improve the selectable number of mask for generating base images identifying different image pickup areas as desired by the user.

Allowable Subject Matter

7. **Claims 3-8** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

9. **Regarding claim 3**, the main reason for indication of allowable subject matter is because the prior art fails to teach or reasonably suggest, that the plurality of types of mask image data recorded in the mask image data record section include the mask image data representing a plurality of types of mask images corresponding to the base image; wherein the display unit one at a time sequentially displays on the base image

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the plurality of types of mask images corresponding to the base image, and each of the sequentially displayed mask images is displayed with the base image until its corresponding combination object image is picked-up and held, and each of the sequentially displayed mask images is one at a time sequentially displayed with the base image and all previously picked-up and held combination object images that correspond to one of the sequentially displayed mask images; wherein the combination object image holding unit holds a plurality of combination object images which are picked up in accordance with the plurality of types of mask images displayed on the display; and wherein the image combining unit combines each of the plurality of combination object images, held by the combination object image holding unit, with the base image at the combining position based on the mask image to specify the image pickup area of the combination object image, including all the limitations of claim 1.

10. **Regarding claims 4-8**, claims 4-8 are objected to as being dependent from a claim 3 which is indicated to have allowable subject matter if incorporated in independent claim 1.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NELSON D. HERNANDEZ whose telephone number is (571)272-7311. The examiner can normally be reached on 9:00 A.M. to 5:30 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nelson D. Hernández Hernández/
Examiner, Art Unit 2622
June 5, 2009